

Applic. No. 10/801,959
Amdt. dated December 30, 2004
Reply to Office action of July 14, 2004

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-10 and 12-14 remain in the application. Claims 1-10 and 12 have been amended. Claim 11 has been cancelled.

In item 5 on page 2 of the Office action, claims 1-14 have been rejected as being fully anticipated by Kwon (U.S. Patent No. 5,913,892) or the article to Maurice-A. Julien under 35 U.S.C. § 102.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and as whole, the claims have, therefore, not been amended to overcome the references. However, in order to facilitate prosecution of the application, claims 1 and 12 have been amended so as to include the subject matter of claim 11.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 12 call for, *inter alia*:

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the spring configuration having at least one individual spring element and at least one additional oscillation-enabled element configured to oscillate at a different resonant frequency than the individual spring element.

The Kwon reference discloses a refrigerator having a compressor. The compressor is connected to the refrigerator housing with a spring configuration. The Kwon reference discloses a moving member (6), which includes a spring (4) and hollow cylindrical buffer members (5).

The reference does not show the spring configuration having at least one individual spring element and at least one additional oscillation-enabled element configured to oscillate at a different resonant frequency than the individual spring element, as recited in claims 1 and 12 of the instant application. The Kwon reference discloses a moving member, which includes a buffer member. The buffer member disclosed by Kwon is a member which only dampens vibrations. The buffer member disclosed by Kwon does not have oscillating capabilities. Accordingly, Kwon does not disclose an oscillation-enabled element. This is contrary to the invention of the instant application as claimed, in which the spring configuration has at least one individual spring element and at least one additional oscillation-enabled

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element configured to oscillate at a different resonant frequency than the individual spring element.

Since claims 1 and 12 are believed to be allowable over Kwon, dependent claims 2-10, 13, and 14 are believed to be allowable over Kwon as well.

The Julien reference does not disclose a refrigerator or refrigerator housing. Therefore, claims 1 and 12 are not anticipated by Julien.

Since claims 1 and 12 are believed to be allowable over Julien, dependent claims 2-10, 13, and 14 are believed to be allowable over Julien as well.

In item 6 on page 2 of the Office action, claims 1-10 and 12-14 have been rejected as being fully anticipated by Hartl et al. (U.S. Patent No. 6,585,241) (hereinafter "Hartl") or by Girodin (FR 79 12386) or by Ichikawa et al. (JP 63-096337) (hereinafter "Ichikawa") or by Fujiwara (JP 59-009335) under 35 U.S.C. § 102. As noted above, claims 1 and 12 have been amended so as to include the subject matter of claim 11.

Claim 11 was not rejected over any of the above-noted references. Therefore, claims 1 and 12 are believed to be allowable over the above-noted references.

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In item 8 on page 3 of the Office action, claim 11 has been rejected as being obvious over Hartl (U.S. Patent No. 6,585,241) or by Girodin (FR 79 12386) or Ichikawa (JP 63-096337) or by Fujiwara (JP 59-009335) in view of Kwon (U.S. Patent No. 5,913,892) under 35 U.S.C. § 103. Since the subject matter of claim 11 was added to claims 1 and 12, this rejection will be discussed with respect to claims 1 and 12.

The Kwon reference discloses that the moving member (6) has one spring (4) and hollow cylindrical buffer members (5). The buffer members in Kwon are not oscillation-enabled elements because the purpose of the buffer members of Kwon is to buffer and absorb horizontal and vertical vibration of the compressor. Because Kwon discloses that the use of the buffer members in the moving member of the compressor is the core of his invention, a person of ordinary skill in the art has no motivation to combine the teaching of Kwon with any one of Hartl, Girodin, Ichikawa, or Fujiwara.

Moreover, a critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In

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re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

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The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is

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insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

In item 9 on page 3 of the Office action, claims 1-10 and 12-14 have been rejected as being fully anticipated by Olgac (U.S. Patent No.5,431,261) or Hamada et al. (U.S. Patent No.5,884,902) (hereinafter "Hamada") or Kato (U.S. Patent Application No. 005967269) under 35 U.S.C. § 102. As noted above, claims 1 and 12 have been amended so as to include the subject matter of claim 11. Claim 11 was not rejected over any of the above-noted references. Therefore, claims 1 and 12 are believed to be allowable over the above-noted references.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 12. Claims 1 and 12 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1 or 12, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-10 and 12-14 are solicited.

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In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

Petition for extension is herewith made. The extension fee for response within a period of three months pursuant to Section 1.136(a) in the amount of \$1020.00 in accordance with Section 1.17 is enclosed herewith.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,



For Applicant(s)

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